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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,435

09/29/2005

Tatsuo Baba

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EXAMINER

GUGLIOTTA, NICOLE T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,435	Applicant(s) BABA, TATSUO	
	Examiner NICOLE T. GUGLIOTTA	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/2005, 5/17/2007, 10/18/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 31, 2008. Examiner contends the restriction is appropriate due to the method requiring a search in class/subclass 264/630, which would not be required for the article.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the intermediate membrane and the filtration membrane must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baba (JP 2001-0340718), in view of Kato et al. (US 2003/0153459 A1).

5. In regard to claims 1, Baba disclose the base material for honeycomb filters with a pore volume distribution within the limits of 50% of the pore diameters (d50) being 5 – 25 micrometers, and was measured by the mercury pressure ON method (Section [012]). Baba is silent in regard to the average surface roughness.

6. In regard to surface roughness, Kato et al. disclose the average surface roughness (Ra_c) of the cell wall is 0.5 μm or more. It is further preferred that in the

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honeycomb structure, the pores having pore diameters of 1 μm or more is 90% or more of the total pore volume, in order to make large Ra and RzDIN (Section [0015]). A Ra_s of more than 10 μm results in too large a surface unevenness, too large a variation in diameter, and too many pores in a honeycomb structure (this leads to a reduced strength and easy breakage) (Section [0036]).

7. It would have been obvious to one skilled in the art at the time the invention was made to have a cell wall surface roughness of 0.5 μm or more and a pore diameter of 1 μm or more, as disclosed by Kato. Baba discloses a pore diameter range more narrow than Kato: between 5 and 23 micrometers. It is well established, however, that the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baba and Kato et al. as applied to claim 1 above, and further in view of Moriya (U.S. Patent No. 5,578,129).

9. In regard to claim 6, Baba disclose the base material for honeycomb filters with which the pore volume distribution which is in within the limits whose 50% pore diameter (d50) is 5 – 25 micrometers, and was measured by the mercury pressure ON method (Section [012]).

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10. In regard to the average surface roughness, see the argument based upon Kato et al. for claim 1.

11. Baba and Kato et al. are silent in regard to the presence of an intermediate membrane and a filtration membrane in a honeycomb filter.

12. Moriya discloses an outlet filter made of a porous ceramic plate formed in to a cylinder. The porous ceramic plate has a multi-layer structure consisting of supporting, intermediate and filtering layers. The average pore diameters of the supporting, intermediate and filtering layers 47, 48, and 49 are about 10 μm , about 1 μm and about 0.2 μm , respectively (Col. 5, Lines 21 - 28). As a result, it is possible to decrease the thickness of the filtering layer 49, which has the smallest average pore diameter, down to a small value of from 30 μm to 20 μm , so that a high filtration function is attained without a pressure loss increased. The intermediate layer 48 arranged between the supporting and filtering layers 47 and 49 prevents ceramic particles forming the filtering layer 49 from being embedded among ceramic particles forming the supporting layer 47 (Col. 6, Lines 49 - 61).

13. It would have been obvious to one skilled in the art at the time the invention was made that the presence of an intermediate layer prevents the filtering layer particles from being embedded in the ceramic particles of the supporting layer. This allows a thinner filtering layer, which in turn results in higher filtration, as taught by Moriya.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE T. GUGLIOTTA whose telephone number is (571)270-1552. The examiner can normally be reached on M - Th 8:30 - 6 p.m., & every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NICOLE T. GUGLIOTTA
Examiner
Art Unit 1794

/Carol Chaney/

Supervisory Patent Examiner, Art Unit 1794